

## **REMARKS / DISCUSSION OF ISSUES**

Claims 1-19 are pending in the application. Claims 1, 10 and 11 are the independent claims.

### **Objections to the Claims**

Claims 1 and 11 are amended to include the suggested language. Applicants respectfully submit that the objections are moot in view of the amendment.

### **Rejections under 35 U.S.C. § 102**

Claims 1-2, 8-11 and 18-19 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated over *Jepsen, et al.* (US PAP 2005/0275386). For at least the following reasons, Applicants respectfully submit that all claims are patentable over the applied art.

At the outset, Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

#### **A. Claims 1, 10 and 11**

Claim 1 recites:

*A decentralized power generation system, said system comprising:*

*a plurality of decentralized power generating units;*

*a plurality of DC/DC converters none of which are configured to buffer energy, wherein each of said DC/DC converters is connected to a respective one of said power generating units and, when a voltage supplied from a respective power generating units meets or exceeds a threshold voltage, the associated DC/DC converter is configured to convert a current provided by said power generating units;*

*a DC bus to which each of said DC/DC converters is coupled for feeding a respectively converted current into said DC bus; and*

*at least one power receiving component connected to said DC bus for retrieving current from said DC bus, wherein the power receiving component is physically separated from said DC/DC converters.*

Claims 10 and 11 each include similar features to the emphasized features of claim 1.

As described in the filed application, the DC/DC converters of the representative embodiments beneficially do not require energy buffering. No electrolytic capacitors (or their equivalent) that are used for energy buffering are required. These devices reduce the durability of the DC/DC converter and thus are deleterious thereto. By contrast, the DC/DC converters of the representative embodiments do not require energy buffering and do not suffer the durability issues.

*Jepsen, et al.* does not disclose DC/DC converters that do not require energy buffering. Therefore, the applied art fails to disclose at least one feature of each of claims 1, 10 and 11. Claims 1, 10 and 11 are patentable over the applied art accordingly. Moreover, claims 2-9 and 12-19, which depend from claims 1 and 11, respectively, are patentable for at least the same reasons and in view of their additionally recited subject matter.

B. Inherency

The Office Action asserts that it is “inherent that the voltage supplied to the Jepsen converters is always above ‘a threshold voltage’.” The Office Action then relegates the threshold voltage to zero (0) volts. No basis of support in the applied art for this assertion is provided. Applicants respectfully submit that the claim of inherency is not proper for at least the following reasons.

M.P.E.P. § 2112 IV provides that:

*EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING  
TO SHOW INHERENCY*

*The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).*

(emphasis added).

Furthermore, a claim rejection must be based on objective evidence of record, and

cannot be supported merely on subjective belief and unknown authority. See, e.g., M.P.E.P. § 2144.03; In re Lee, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); In re Zerko, 258 F.3d at 1386, 59 USPQ2d at 1697.

No such concrete evidence has been provided by the Examiner here, nor did the Examiner submit an affidavit as required by 37 C.F.R. § 1.104(d)(2) if this proposed motive were based on facts within his personal knowledge (see M.P.E.P. § 2144.03). Applicants respectfully request that such an affidavit be provided if a rejection continues to be made without a citation of any objective evidence.

Accordingly, Applicants respectfully submit that the alleged inherent disclosure has not been established. Therefore, the rejection of claims for anticipation is improper for these additional reasons.

### **Rejections under 35 U.S.C. § 103**

The rejections under this section of the Code have been considered. While Applicants in no way concede the propriety of the rejections, these rejections are directed to dependent claims. All dependent claims are patentable for at least the same reasons and in view of their additionally recited subject matter.

### **Conclusion**

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:

Phillips Electronics North America Corp.

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